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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,991	12/11/2003	Ellis Verosub	AOL0113	8868

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GLENN PATENT GROUP
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EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3600

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02/04/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/734,991

Applicant(s)

VEROSUB ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9-7-04</u> . | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 30-38 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 30-38 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: purchasing the asset and tracking and storing a client usage of content.

Claims 31-38 are also rejected as each depends from claim 30.

4. Claims 30-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 recites "*controlling usage* of the purchase asset..." and "updating the usage rights.... in accordance to *the controlled usage*" (emphasis added).

The term "controlling usage", however, is not necessarily an action, a step or a

positive recitation. For example, while a door "controls" who can enter a room, it does not actively performing a step of "controlling" (i.e. hanging is not controlling). Therefore, absent a step of tracking how usage of the asset is controlled (e.g. computer prevented a user's attempt to send the asset to another) or at least how the asset is used (e.g. played four times) Applicant's "updating" step is unclear to one of ordinary skill (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

Claim 30 recites the limitations "the purchased asset" and "the controlled usage" in lines 4 and 16-17, respectively. There is insufficient antecedent basis for these limitations in the claim.

Claims 31-38 are also rejected as each depends from claim 30.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 30-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peinado et al., U.S. Patent No. 6,772,340 in view of Milstead et al., U.S. Patent No. 6,263,313.

As per claims 30-38, Peinado et al. teach a process comprising:

- sending purchase information for an asset (e.g. song, album, video, movie or game) from a client machine to a server (figure 1, items 12p, 14 and 22- "distribution channel"; column 10, lines 3-18; column 14, lines 44-57)
- sending the purchased asset from the server to the client (figure 1, items 12p, 14 and 22- "distribution channel"; column 10, lines 3-18; column 17, lines 5-12)
- sending a license request from the client to the server (column 11, lines 40-45)
- sending a license from the server to the client the license comprising an asset key and usage rights (column 5, lines 25-30; column 10, lines 13-18; column 11, lines 40-58; column 17, lines 5-11)
- controlling usage of the asset with the client based on the license (column 13, lines 15-20; column/line 17/60-18/8)
- updating the usage rights within the client machine (i.e. adding newly acquired rights for newly acquired content in a rights database on a user computer) in accordance to the controlled usage (i.e. wherein the rights are the rights used to control corresponding content) (figure 4, item 38; column 13, lines 15-20; column 15, lines 25-40; column 16, lines 15-28; column/line 17/60-18/8; column 21, lines 53-63)

- saving the purchased asset to an asset store at the client machine
(column/line 13/60-14/3)
- attaching machine characteristics (e.g. unique identifier or fingerprint associated with a client machine) to the license (column/line 47/63-48/29; column 51, lines 28-33; column 52, lines 6-23- "chain", "link")
- securely storing the license at the client machine (figure 4, item 38; column 16, lines 15-28)
- launching a digital content player (column/line 14/15-15/20)
- allowing usage of the content by the content player dependent on the presence of a content (i.e. asset) key and usage rights (column 13, lines 8-33; column/line 14/15-15/20; column/line 15/52-16/14; column 17, lines 5-11; column/line 17/60-18/8)

Conclusion

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Calvin Loyd Hewitt II
Primary Examiner

January 17, 2008